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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/736,070

12/15/2003

James C. Stebnicki

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07/24/2006

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,070

Applicant(s)

STEBNICKI ET AL.

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 4, 7, 8, 11, 12, 14, 18, 21 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 9, 10, 13, 15-17, 19, 20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3-18-04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species A, Figures 2-4 and Species G in the reply filed on 7-3-06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). It is noted that claims 12 and 25 are also withdrawn with claims 4, 7, 8, 11, 14, 18 and 21 because claims 12 and 25 recite a non-circular cross section opening. Figures 2-4 show a circular cross section opening.

Claim Objections

2. **Claim 2** is objected to because of the following informalities: claim 2 depends upon claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3, 5, 13, 19 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Moe (US2572276).

Moe teaches a method of making a return roller for use in a conveyor system (col. 1, lines 9-10) comprising: extruding (col. 1, line 54) an elongated roller core (the cylindrical portion labeled 3) defining a radially outwardly facing surface, and including an axial opening 2 for receiving a shaft 1, and coextruding (col. 1, line 54) a coating (cylindrical portion labeled 5) over the radially outwardly facing surface for engagement with a conveyor belt. The inner portion 3 and outer portion 5 is considered to be “co-extruded” because they are extruded together at the same time. Note the discontinuity 12. Moe inherently teaches “indicating wear” of the coating (cylindrical portion labeled 5) because during normal use, the material of the coating will wear down and can be noticed visibly. The discontinuity 12 does not expose the radially outwardly facing surface of the core when looking at the surface of the discontinuity 12. The outer surface of the cylindrical portion labeled 3 is considered to form an outer cylindrical shell to define the radially outwardly facing surface.

Regarding claim 13, Moe teaches: extruding an elongated core 3 defining a radially outwardly facing surface, coextruding a coating 5 “onto” (via 6) the outwardly facing surface which bonds to at least a portion of the radially outwardly facing surface, and forming at least one axially extending discontinuity 12. The radially outwardly facing surface 3 is considered “an outer cylindrical shell defining the outwardly facing surface”.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3726

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1, 5 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adkisson et al. (US4453848) in view of Lauhus (US6182333).

Adkisson et al. teach extruding (col. 2, lines 32-33) an elongated roller core defining a radially outwardly facing surface **202**, and including an axial opening **264** for receiving a shaft **260**, and applying a coating **240** over the radially outwardly facing surface **202**. Regarding the limitations “for use in a conveyor system” and “for engagement with a conveyor belt”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Although Adkisson et al. teach that the coating can be applied by conventional methods (col. 3, lines 35-36), Adkisson et al. do not specifically teach coextruding the coating.

Lauhus teaches coextruding (col. 2, line 2) as a way to coat a covering over a cylindrical socket in order to create a fixed bonding (col. 2, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson et al. with coextruding, in light of the teachings of Lauhus, in order to securely fasten the coating to the core.

Note Adkisson et al. teach an outer cylindrical shell **202** and inner cylindrical shell **204** joined by at least one spoke **216**.

Art Unit: 3726

7. **Claims 2-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adkisson et al. in view of Lauhus as applied to claim 1 above, and further in view of Moe.

Adkisson et al./Lauhus teach the invention cited above with the exception of having a discontinuity in the coating.

Moe teaches a discontinuity on a coating **12**.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson et al./Lauhus with a discontinuity, in light of the teachings of Moe, in order to provide a better gripping surface.

8. **Claims 9, 15 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moe in view of Lauhus.

Moe teaches the invention cited above with the exception of coextruding the core onto a shaft.

Lauhus teaches that the concept of coextruding is well known (col. 2, line 2) to provide a fixed bonding.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Moe with coextruding, in light of the teachings of Lauhus, in order to provide a secure bond between the core and shaft.

Moe teaches that any extrudable material could be used (col. 1, lines 36-37).

Lauhus teaches that thermoplastic could be used as an extrudable material (col. 1, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Moe with thermoplastic material as the extrudable material, in light of the teachings of Lauhus, in order to provide a high strength and extrudable material.

9. **Claims 10 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moe in view of Anderson (US1235753).

Moe teaches the invention cited above with the exception of fixing an end cap to each end of the core.

Anderson teaches fixing an end cap **16** to each end of a core.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Moe with end caps, in light of the teachings of Anderson, in order to prevent debris from entering the roll and in order to provide a more rigid support for the shaft.

10. **Claims 13, 15-17, 19, 20, 22 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adkisson in view of Lauhus and Moe.

Adkisson teaches the invention cited above with the exception of coextruding the coating **240** onto the outwardly facing surface **202** and forming at least one discontinuity. Although Adkisson et al. teach that the coating can be applied by conventional methods (col. 3, lines 35-36), Adkisson et al. do not specifically teach coextruding the coating.

Art Unit: 3726

Lauhus teaches coextruding (col. 2, line 2) as a way to coat a covering over a cylindrical socket in order to create a fixed bonding (col. 2, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson et al. with coextruding, in light of the teachings of Lauhus, in order to securely fasten the coating to the core.

Moe teaches a discontinuity on a coating **12**.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson et al./Lauhus with a discontinuity, in light of the teachings of Moe, in order to provide a better gripping surface.

Lauhus teaches that the concept of coextruding is well known (col. 2, line 2) to provide a fixed bonding.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson with coextruding the core and shaft, in light of the teachings of Lauhus, in order to provide a secure bond between the core and shaft.

Lauhus teaches that thermoplastic could be used as an extrudable material (col. 1, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson et al. with thermoplastic material as the extrudable material, in light of the teachings of Lauhus, in order to provide a high strength and extrudable material.

Adkisson et al. teach providing a coating **240** having greater coefficient of friction than the core **204**.

11. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Adkisson in view of Lauhus and Moe as applied to claim 13 above, and further in view of Anderson.

Adkisson/Lauhus/Moe teach the invention cited above with the exception of fixing an end cap to each end of the core.

Anderson teaches fixing an end cap **16** to each end of a core.

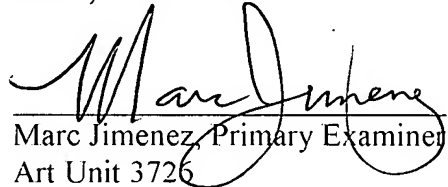
Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Adkisson/Lauhus/Moe with end caps, in light of the teachings of Anderson, in order to prevent debris from entering the roll and in order to provide a more rigid support for the shaft.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3726

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Marc Jimenez, Primary Examiner
Art Unit 3726

MJ

7-18-06